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| 10/662,752 | 09/15/2003 | Rebecca L. Twigg | CING-124 | 1547 |
| 36013 7590 01/06/2009 MOAZZAM & ASSOCIATES, LLC 7601 LEWINSVILLE ROAD SUITE 304 MCLEAN, VA 22102 | | | | |
| EXAMINER | | | | |
| PEACHES, RANDY | | | | |
| ART UNIT | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/662,752

Applicant(s)

TWIGG ET AL.

Examiner

RANDY PEACHES

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-22 is/are allowed.
- 6) ☒ Claim(s) 4-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. **Claims 4-10** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. According to the ***"Interim Guidelines of Examining Patent Application for Patent Subject Matter Eligibility"*** pp. 20-22, the Examiner has determined that the final result of the claimed language fails to provide a "tangible" result. According to the description of "logic" stated in paragraph [0020] of the instant Specification, a signal is abstract. Accordingly, the referenced claims merely teach of a signal; thus, failing to provide a 'tangible" result. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 11-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vuoristo et al. (U.S. Patent Application 6,603,969 B1) in view of Mills (U.S. Patent Number 5,915,225).

Regarding **claim 11**, Vuoristo et al. discloses a network comprising:

- a base station subsystem (BSS). See column 12 lines 1-10;
- subscriber information. See column 11 lines 54-67; and
- one or more network elements of the network, locate subscriber data in response to a communication from a terminal device, identifies subscriber services, determines terminal device settings, and communicates the settings to the terminal device. See column 12 lines 1-65.

However, because Vuoristo et al. is silent in detailing wherein SIM generated information is transmitted back to the network.

Mills teaches in column 5 lines 40-46, wherein a network requests information from a SIM via an SMS message and the SIM transmits the requested information back to the network via another SIM-generated SMS message for processing.

Therefore at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify Vuoristo et al to include Mills in order to provide a means for the said SIM to transmit information back to the network.

Regarding **claim 12**, as the combination of Vuoristo et al. and Mills are made, the combination according to **claim 11**, Vuoristo et al. discloses a network further comprising:

- one or more network elements to communicate with the terminal device using one of SMS, EMS, MMS, and SyncML. See column 5 lines 48-58.

Regarding **claim 13**, as the combination of Vuoristo et al. and Mills are made, the combination according to **claim 11**, Vuoristo et al. discloses a network further comprising:

- one or more network elements to communicate configuration software to the terminal device; the configuration software comprising logic that, when applied by the terminal device, effects the device settings. See column 12 lines 1-65.

Allowable Subject Matter

2. ***Claims 14-22*** are allowed.

Response to Arguments

Applicant's arguments filed 9/15/2008 have been fully considered but they are not persuasive.

Regarding the Applicant's arguments in regards to the 101 rejection, the Examiner maintains that based on the defined language identified by the Examiner in the above rejection, clearly renders that languages abstract and thus, the 101 rejection is valid and is maintained.

Regarding the claim rejection of claims 11-13, the Applicant argues that Vuorista does not disclose any device which contains an active SIM that receives and transmits, produces and discerns information relating to the device and environment. In contrast, the SIM disclosed in Vuorista retains a passive role to be referred to by the device for passive and static information.

However, after a further look at independent claim 11, Applicant does not claim an active SIM and therefore the rejection of the claim is based on the claimed language that is presented. Therefore, Vuorista does indeed teach on the claimed language that is presented. **Claims 11-13** stand rejected.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **RANDY PEACHES** whose telephone number is (571) 272-7914. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Randy Peaches/
Examiner, Art Unit 2617

/NICK CORSARO/
Supervisory Patent Examiner, Art Unit 2617